

REMARKS

The present communication is responsive to the Official Action of March 19, 2009, in the nature of an election/restriction requirement. Claims 1-29 and 36-50 presently appear in this case. No claims have yet been acted upon on the merits. All of the claims have been subject to a restriction requirement. The Official Action of March 19, 2009, has now been carefully studied. Reconsideration and withdrawal of the restriction requirement and prompt consideration on the merits and allowance of all of the claims now present in the case are hereby respectfully urged.

The examiner has required restriction under 35 USC §121 and 372. The examiner states that the application contains inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. The examiner has required applicant to elect a single invention to which the claims must be restricted from among:

Group I, the compounds, compositions and methods according to claims 1-29 and 36-50 of formula I and

Group II, including the compounds, compositions and methods according to claims 1-29 and 36-50 of formula II.

The examiner notes that both of these groups are classifiable in the same class and subclasses. The examiner states that the two groups do not relate to a single general inventive concept because they lack the same or corresponding special technical features. The examiner states that the compounds of the two groups are different compounds and therefore there is no special technical feature or unity of invention. The examiner has identified the special technical feature as the aromatic/heterocyclic ring structure of instant formula I, but the examiner states that this does not define a contribution over the prior art. The examiner states that even if there were a special technical feature which united the groups, there would still not be unity of invention in view of 37 CFR 1.475. This requirement is respectfully traversed.

The present application contains three independent claims, 1, 18 and 42. Claim 18, while independent, is clearly one of the species listed in claim 17, which is ultimately dependent from claim 1. Claim 42 is drawn to an intermediate, but the examiner has considered that claim 42 will be examined with claims 1-29 and 36 to 50. With respect to claim 1, the examiner's attention is drawn to MPEP 1850 (which is applicable to national stage applications, as stated in MPEP 1893.03(d)), particularly where it states in Section II:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependant claims. ...

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claim.

Here, the examiner refers to the formulas I and II, but there are no formulas I and II in claim 1. These formulas appear in dependent claim 7. Unity of invention must be determined with respect to claim 1, not claim 7. Claim 1 is a true generic claim and the special technical feature described therein is a bacteriochlorophyll derivative containing at least one negatively charged group and/or acid group that is converted to a negatively charged group at physiological pH. This special technical feature is not shown in any prior art that the examiner has cited. It is applicable to all of the compounds of the dependent claims. All of the compounds within the scope of claim 1 share this special technical feature. Accordingly, restriction of claim 1 is inappropriate and should be withdrawn.

The examiner states that even if there were a special technical feature, there must be unity of invention also. This statement is incorrect. Unity of invention is defined by the special technical feature.

Further, the examiner states:

The above groups 1-9 together do not meet the requirement of unity of invention as given above in (1)-(5).

This statement is not understood as there are only two groups that have been defined "above". This part of the requirement therefore must have been inserted in error.

In order to be responsive, however, applicant elects the compounds, compositions and methods of formula II, i.e., the second listed group. The examiner states "that the election of the invention of the compound must fall within the elected group." This is not understood as the examiner has not required election of a compound, but only election of one of the inventions of group I and II. Nevertheless, to expedite examination, applicant further elects compound 4 as the preferred specific compound.

Accordingly, reconsideration and withdrawal of this restriction requirement and examination of all of the claims now present in the case are hereby earnestly solicited.

Respectfully submitted,

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